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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/685,079	10/06/2000	Jay S. Walker	00-039	3152

7590 07/17/2006  
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EXAMINER

ZEENDER, FLORIAN M

ART UNIT PAPER NUMBER

3627

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/685,079

Applicant(s)

WALKER ET AL.

Examiner

F. Ryan Zeender

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36, 38 and 39 is/are pending in the application.
- 4a) Of the above claim(s) 3, 8 and 10-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-7, 9, 13-36, 38 and 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-36 and 38-39 are pending the application. Claims 3, 8, and 10-12 are withdrawn from consideration.

#### ***Double Patenting***

Claims 1, 2, 4-7, 9, 13-36, 38 and 39 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-63 of U.S. Patent No. 6,415,262.

As to claims 1, 2, 4-7, 13-15, 23, 25-28, 31-36, 38 and 39, although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ only in scope.

As to claims 9, 13 and 14, the claims of '262 show all elements of the claims except that the security deposit comprises a reduction of an amount of credit available to the customer via a credit card. However, the examiner takes official notice that to provide a security deposit in such a manner is notoriously old and well known in the art (e.g., providing a security deposit against a credit card when renting a car, the security deposit reducing the amount of credit available on the card.) It would have been obvious to one of ordinary skill in the art to modify the method of the claims of '262 by providing the deposit in this way in order to take advantage of the existing credit card system.

As to claims 16-24, the claims of '262 show all elements except the information taken into account in determining the deposit. However, the examiner takes official notice that the use of the claimed information in determining the deposit, as claimed, is

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notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method of the claims of '262 by using the recited information in order to provide an appropriate deposit amount, related to the particular circumstances of the transaction.

As to claim 29, the claims of '262 show all elements except verifying the information. However, the examiner takes official notice that to verify received information is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method of the claims of '262 by doing so in order to ensure that the information is correct.

As to claim 30, the claims of '262 show all elements of the claim except that the information comprises a hash value. However, the examiner takes official notice that providing a hash value is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to do so in order to facilitate secure communication.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 7, 15, 25, 27, 28, 31, 32 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Phillips et al (5,870,459).

Phillips shows arranging via a processing device for a benefit to be applied to a transaction, the benefit being the temporary provision of a wireless phone in conjunction with the purchased communication time, in exchange for a future performance of a task associated with a third party, comprising returning the phone (it is noted that the phone can be returned to a third party via the mail). Phillips also shows providing the benefit before performance of the task; arranging for the security deposit, and arranging for the return of the security deposit upon performance of the task. (See for example; Col. 12, lines 31-41; Col. 3, lines 22-28; Col. 19, lines 34-55)

***Claim Rejections - 35 USC § 103***

Claims 9, 13, 14, 16-24, 26, 28-29, 30 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al.

As to claim 9, 13, 14, Phillips shows all elements of the claims except that the security deposit comprises a reduction of an amount of credit available to the customer via a credit card. However, the examiner takes official notice that to provide a security deposit in such a manner is notoriously old and well known in the art (e.g., providing a security deposit against a credit card when renting a car, the security deposit reducing the amount of credit available on the card.) It would have been obvious to one of ordinary skill in the art to modify the method of Phillips by providing the deposit in this way in order to take advantage of the existing credit card system.

As to claims 16-24, Phillips shows all elements except the information taken into

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account in determining the deposit. However, the examiner takes official notice that the use of the claimed information in determining the deposit, as claimed, is notoriously old and well-known in the art. It would have been obvious to one of ordinary skill in the art to modify the method of Phillips by using the recited information in order to provide an appropriate deposit amount, related to the particular circumstances of the transaction.

As to claims 26 and 28, Phillips teaches providing a security deposit for a phone and providing payment for a predetermined amount of time of use of the phone (Col. 19, lines 46-51). Phillips further teaches that the phone is returned by the customer to a “service center or other designated destination” (Col. 6, lines 43-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to have the service center or other designated destination return the security deposit to the customer (acting as the “subsidy provider” claimed by applicant), as the service center now has the product in hand. Re claim 28: The mailing of the phone by the customer to the service center constitutes the receiving of information associated with the performance of the task (i.e., returned phone).

As to claim 29, Phillips shows all elements except verifying the information. However, the examiner takes official notice that to verify received information is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method of Phillips by doing so in order to ensure that the information is correct.

As to claim 30, Phillips shows all elements of the claim except that the information comprises a hash value. However, the examiner takes official notice that

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providing a hash value is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to do so in order to facilitate secure communication.

As to claims 33-35, Phillips shows all elements except an apparatus that arranges for the performed steps.

However, the examiner takes official notice that it is notoriously old and well known to provide an apparatus to perform the recited steps (e.g., a computerized system that dispenses and tracks the return of the phones). It would have been obvious to one of ordinary skill in the art to do so in order to reduce the amount of manual work required and to reduce error by automatic tracking.

As to claim 36, Phillips shows all elements except software performing the performed steps. However, the examiner takes official notice that it is notoriously old and well known to provide software to perform the recited steps (e.g., a computerized system that dispenses and tracks the return of the phones). It would have been obvious to one of ordinary skill in the art to do so in order to reduce the amount of manual work required and to reduce error by automatic tracking.

Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al., as applied to claim 1 above, and further in view of Shavit et al.

Phillips et al disclose the limitations of the claims except "transmitting" to the customer an offer to apply the benefit in response to receiving an indication that the

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customer is interested in purchasing an item, and "receiving" a response from the customer to the offer.

Shavit et al teach an e-commerce system whereby information is transmitted to a customer about additional or substitute items (See for example Col. 13, lines 7-10) in response to an indication that the customer is interested in purchasing an item; and receiving a response from the customer to the offer (See for example; Col. 13, lines 10-57).

It would have been obvious to one of ordinary skill in the art to modify Phillips et al to transmit to the customer an offer to apply the benefit in response to receiving an indication that the customer is interested in purchasing an item, and receive a response from the customer to the offer, in view of Shavit et al., in order to help the customer identify the product best suited for his/her needs (Shavit et al., Col. 13, lines 51-55).

### ***Response to Arguments***

Applicant's arguments filed 4/21/2006 have been fully considered but they are not persuasive.

With respect to the double patenting rejection (Walker) and the rejection under 35 USC 103 (Phillips et al.), the applicant uses a similar argument to traverse the use of Official Notice. However, the applicant has **improperly** traversed the use of Official Notice in that the applicant has not specifically stated **why the noticed facts are not considered to be common knowledge or well known in the art**, as required by MPEP 2144.03, section C. Therefore, the rejections using Official notice are maintained.



The applicant further argues on page 7, last paragraph, that in Phillips et al., the provision of the telephone and the communication services is the subject of the "transaction" and is not at all associated with any "benefit" other than the transaction itself. However, the argument is not persuasive in that Phillips et al. teach that there may be two different types of credit card authorizations; one for the rental fee for use of the telephone for a predetermined period of time; and a second for a deposit guaranteeing return of the telephone following the expiration of the predetermined period of time (See Col. 19, lines 46-53). Thus, the "benefit" is the provision of the phone at no extra charge when the phone is returned. The "benefit" of the phone is not actually part of the transaction comprising the phone time/minutes.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Ryan Zeender whose telephone number is (703) 308-8351. The examiner can normally be reached on Monday-Friday, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on (571) 272-6771. The receptionist's phone number for the Technology center is (571) 272-3600.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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F. Zeender

Primary Examiner, A.U. 3627

July 12, 2006

 7/12/06

**F. RYAN ZEENDER**  
**PRIMARY EXAMINER**